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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,186	04/07/2004	Thomas R. Marsh	9066-23DV	7421
20792	7590	05/05/2005	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC PO BOX 37428 RALEIGH, NC 27627			LUGO, CARLOS	
			ART UNIT	PAPER NUMBER

3676

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/820,186	Applicant(s) MARSH ET AL.	
	Examiner Carlos Lugo	Art Unit 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11 and 13 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to applicant's amendment filed on February 25, 2005.

Claim Objections

2. **Claim 5 is objected** to because of the following informalities:
 - Claim 5 Line 7, change "the projection has a convex portion extending outwardly from the second face of the base member and the base member has a planar portion" to -the projection has a convex portion extending outwardly from the second face of the base member and a planar portion opposite the convex portion, the base member has a planar portion-.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-4,6-9, and 11 are rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 2,161,648 to Widman.

Regarding claim 1, Widman discloses a device (30) for protecting first and second confronting components (12 and 23).

The device comprises a base member (31) having opposite first and second faces. The first face is adapted to contact the first component (12). The base

member has a cushioning projection (32) extending outwardly from the second face of the base member and covering and defining a void within the base member (void between 31 and 32). The projection is adapted to contact the second component (23) as it confronts the first component.

The device further comprises a clip (34) connected to the base member and configured to attach the device to one of the first and second components.

As to claim 2, Widman illustrates that the device is formed as a unitary member (Figure 3).

As to claim 3, Widman discloses that the device is formed of a polymeric material (Col. 2 Lines 25-30).

As to claim 4, Widman illustrates that the projection has a convex portion extending from the second face of the base member and the base member has a planar portion across from the void.

As to claim 6, Widman illustrates that the convex portion of the projection has a thickness that is less than the thickness of the base member.

As to claim 7, Widman illustrates that the cushioning projection is elongated in a direction generally perpendicular to the thickness of the base member (Figure 3).

As to claim 8, Widman illustrates that the cushioning projection is generally semi-circular.

As to claim 9, Widman illustrates that the cushioning projection comprises an opening at least in one end.

As to claim 11, Widman illustrates that the cushioning projection could have a thickness of between .020 and .090 inches.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 13 is rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 2,185,161 to Tinnerman.

Regarding claim 1, Tinnerman discloses a device (C) for protecting first and second confronting components (A and B).

The device comprises a base member having opposite first and second faces. The first face is adapted to contact the first component (B). The base member has a cushioning projection extending outwardly from the second face of the base member and covering and defining a void within the base member (Figures 1 and 2). The projection is adapted to contact the second component (A) as it confronts the first component.

However, Tinnerman fails to disclose that the base member has a planar portion extending away from the cushioning projection on opposite sides of the projection. Tinnerman only discloses that the base member has a planar portion extending away from the cushioning projection on one side of the protrusion.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have two planar portions at opposing sides of the projection, instead of having only one portion, since the duplication of components of a prior art device is a design consideration within the skill of the art. Furthermore, the current specification fails to show or demonstrate any showing of criticality having these planar portions at opposite sides of the projection.

7. **Claim 10 is rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 2,161,648 to Widman as applied to claim 1 above, and further in view of US Pat No 2,185,161 to Tinnerman.

Widman fails to disclose that the cushioning projection is closed at both ends.

Tinnerman teaches that it is well known in the art to have a cushioning projection (C) that is closed at both ends.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have both ends of the cushioning projection closed, as taught by Tinnerman, into a device as described by Widman, since it is considered as a design consideration within the skill in the art because it would not affect the contact between the first and second components.

Allowable Subject Matter

8. **Claim 5 is allowed** (after making the appropriated correction, see Claims Objections section above).

Response to Arguments

9. Applicant's arguments filed on February 25, 2005 have been fully considered but they are not persuasive.

As to applicant's arguments that the amendment to claim 1 overcomes the rejection in view of Tinnerman (Page 8 Line 1), the amendment overcomes the rejection in view of Tinnerman. However, as advance above, new rejections to the claims have been made based on Widman.

Conclusion

10. Applicant's amendment, that the device further includes a clip member, as claimed in claim 1 line 8, necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3676

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number 571-272-7058. The examiner can normally be reached on 9-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

C.L.

Carlos Lugo
AU 3676

April 21, 2005.

Daniel P. Stodola

DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600